

**REMARKS**

In the final Office Action,<sup>1</sup> the Examiner rejected all pending claims 1-6, 8-14, 19-22, 24-33, and 35-40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,587,835 to Treyz et al. ("*Treyz*"). Applicant respectfully traverses the rejection.

Regarding independent claim 1, Applicant asserted, in the previous Amendment filed January 19, 2007, that *Treyz* does not disclose the electronic guide information processing system of claim 1, comprising "an information distributing apparatus for converting the guide information into electronic guide information." In the Office Action, the Examiner maintained the rejection of claim 1, arguing, "*Treyz* discloses providing a digital brochure . . . [w]hich would inherently include converting the guide information into the necessary digital format." Office Action, p. 11. Applicant respectfully disagrees.

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." M.P.E.P. § 2131.01 (quoting *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)).

The Examiner failed to cite any extrinsic evidence to support the alleged inherency. Furthermore, the "store computer" of *Treyz* need not necessarily comprise

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

an apparatus for converting a brochure into an electronic brochure, because, for example, electronic brochure may be inputted to the “store computer” of *Treyz* and, thus, no conversion would be required inside the “store computer” of *Treyz*. Even the Examiner acknowledges, “a brochure must have been converted . . . into digital format [at] some point” (Office Action, p. 11), not necessarily inside of and by the “store computer” of *Treyz*.

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)) (emphasis in original). Accordingly, the Examiner has failed to show inherency by merely stating that a conversion of a brochure into an electronic brochure **may** be performed by the “store computer” of *Treyz*, but failing to show that the “store computer” of *Treyz* must necessarily perform the conversion.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *Id* (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Because an already-converted electronic brochure may be inputted to the “store computer” of *Treyz* and because the “store computer” of *Treyz* need not comprise an apparatus for converting a brochure into an electronic brochure, a conversion apparatus is not inherent to the “store computer” of *Treyz*.

Therefore, *Treyz* does not disclose or suggest the electronic guide information processing system of claim 1, comprising “an information distributing apparatus for converting the guide information into electronic guide information.” Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-4 and 28-31.

Regarding independent claim 5, Applicant asserted, in the previous Amendment, that *Treyz* does not disclose the electronic guide information processing system of claim 5, comprising “an information collecting apparatus for collecting the electronic guide information.” In the Office Action, the Examiner maintained the rejection of claim 5, arguing, “*Treyz* does disclose wherein the shopping assistance link is deleted along with icon/descriptive information once . . . the user has exited the range of service.” Office Action, p. 11. Applicant respectfully disagrees.

Claim 5 includes two distinct recitations: “the electronic guide information is collected” and “the electronic guide information is erased.” *Treyz* merely discloses that the shopping assistance link is deleted. *Treyz* does not disclose or suggest any collection of electronic guide information. Therefore, *Treyz* does not disclose or suggest the electronic guide information processing system of claim 5, comprising “an information collecting apparatus for collecting the electronic guide information.” Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 5, 6, 8-14, 32, 33, and 35-40.

Regarding independent claim 19, Applicant asserted, in the previous Amendment, that *Treyz* does not disclose the “portable terminal apparatus” comprising “a manipulation section” at least because *Treyz* does not teach or suggest that the

“handheld computing device 12” comprises the “computer 184” of *Treyz*. *Treyz* specifically discloses that the “handheld computing device 12” and the “computer 184” are separate, and that one does not comprise the other. *See, e.g., Treyz*, Fig. 13 and col. 20, lines 66-67. However, in the Office Action, the Examiner maintained the rejection of claim 19, merely citing Fig. 13 of *Treyz*. Figure 13 does not show the “handheld computing device 12” comprising the “computer 184.” Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 19-22 and 24-27.

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By:           /Michael R. Kelly/            
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